

STATEMENT IN SUPPORT OF PRE-APPEAL BRIEF REQUEST FOR REVIEW

1. Statement of Clear Error in Rejection

Claims 39, 41 and 44-51 are pending. In a Final Office Action dated April 30, 2008, the Examiner rejected Claims 39, 41, and 44-51 under 35 U.S.C. § 103(a) in light of *Isola et al.* (U.S. Patent No. 3,613,133) and common knowledge.

The rejection is in error for failing to realize that there exists a significant relationship between the blanket and the drawings on the blanket and that the relationship does bear patentable weight.

2. Response to Statements of the Office Action

The Office Action, at page 3, alleges that “[i]t has been held that when the claimed printed matter is not functionally related to the substrate, it will not distinguish the invention from the prior art in terms of patentability. Therefore when the prior art describes all of the claimed structural and functional relationships (in this case, the function of the printed matter on the blanket shows the placement of the user and wherein the blanket surfaces support the indicia, which is the same function as *Isola et al.* (between the descriptive material and the substrate, but prior art describes a different descriptive material than the claim, then the descriptive material is non-functional and will be given patentable weight.))”.

Applicants respectfully submit that the Office Action’s interpretation of the Applicants’ arguments may itself be a potential flaw sufficient to constitute a basis for reversal by the Appeals Board. Applicants raise this issue with the pre-appeal brief conference panel, in part, to preserve the Applicants’ right to appeal the final rejections on this basis alone.

The PTO argues that Applicants’ claim merely teaches a new use for an existing product. Thus, according to the PTO, in order to qualify for a patent, the printed matter must be functionally related to the underlying object. “The critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate.” Applicants, on the other hand, respectfully suggest that the Examiner may misapprehend the requirement of relation as set forth in *In re Ngai*, 367 F.3d 1336, 1339 (Fed. Cir. 2004), upon which she relies:

The dispute between Ngai and PTO reduces to the question of the proper meaning of *Gulack*. The PTO has the better argument. In *Gulack*, the Board rejected a claim directed to a circular band designed for mathematical and educational purposes. The invention consisted of “(1) a band, ring, or set of concentric rings; (2) a plurality of individual digits imprinted on the band or ring at regularly spaced intervals; and (3) an algorithm by which the appropriate digits are developed.” The rejection was premised upon the fact that a circular band with items printed upon it was well known in the art. We reversed, finding that the numbers printed on the band had a functional relationship to the band itself. The Court stated: “the[] digits are related to the band in two ways: (1) the band supports the digits; and (2) there is an endless sequence of digits--each digit residing in a unique position with respect to every other digit in an endless loop. Thus, the digits exploit the endless nature of the band.” Although the prior art disclosed a band with printed matter, the Court concluded that the prior art neither “disclosed nor suggested either feature” of Gulack’s invention.

In re Ngai, 367 F.3d 1336, 1339 (Fed. Cir. 2004).

Differences between an invention and the prior art cited against it cannot be ignored merely because those differences reside in the content of the printed matter. *In re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1983). Under section 103, an Examiner cannot dissect a claim, excise the printed matter from it, and declare the remaining portion of the mutilated claim to be unpatentable. The claim must be read as a whole. If the Examiner meant to disregard that basic principle of claim interpretation, the PTO has committed a reversible error.

A “printed matter rejection” under § 103 stands on questionable legal and logical footing. Standing alone, the description of an element of the invention as printed matter tells nothing about the differences between the invention and the prior art or about whether that invention was suggested by the prior art. A printed matter rejection is based on case law antedating the 1952 patent act, employing a point of novelty approach. *In re Sterling*, 21 C.C.P.A. 1134, 70 F.2d 910, 21 U.S.P.Q. (BNA) 519 (1934). The 1952 act legislatively revised that approach through its requirement that the claim be viewed as a whole in determining obviousness. *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q. (BNA) 459, 15 L. Ed. 2d 545, 86 S. Ct. 684 (1966). When it existed as such, the CCPA had considered all of the limitations of the claims, including the printed matter limitations, in determining whether the invention would have been obvious. *See In re Royka*, 490 F.2d 981, 180 U.S.P.Q. (BNA) 580 (CCPA 1974); *In re Cavrigh*, 59 C.C.P.A. 883, 451 F.2d 1091, 172 U.S.P.Q. (BNA) 121 (1971). In *Royka*, 490 F.2d at 985, 180 U.S.P.Q. (BNA) at 583, the CCPA, notably weary of reiterating this point, clearly stated that printed matter may well constitute structural limitations upon which patentability can be predicated.

Obviousness is a statutory creature now defined in 35 U.S.C. § 103 (2004). The Supreme Court of the United States and the Federal Circuit Court of Appeals have provided further guidance for resolving the question of obviousness. “An obviousness determination is ***not the result of a rigid formula*** disassociated from the consideration of the facts of a case. Indeed, the common sense of those skilled in the art demonstrates why some combinations would have been obvious where others would not. See *KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1739, 167 L.Ed.2d 705 (2007).” *Leapfrog Ent., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 82 USPQ2d 1687 (Fed. Cir. 2007). (Emphasis added.)

Section 103 specifically provides that: “[a] patent may not be obtained if the differences between the subject matter sought to be patented and the prior art are such that the subject matter ***as a whole*** would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” (Emphasis added.) See *Graham*, 383 U.S. 1, 148 U.S.P.Q. (BNA) 459, 15 L. Ed. 2d 545, 86 S. Ct. 684; *Flook*, 437 U.S. at 594 n.16, 198 U.S.P.Q. (BNA) at 199 n.16 (noting the § 103 requirement of reading claims as a whole and extending that requirement to § 101); *Diamond v. Diehr*, 450 U.S. 175, 188, 209 U.S.P.Q. (BNA) 1, 9, 67 L. Ed. 2d 155, 101 S. Ct. 1048 (1981) (also applying that requirement in a § 101 setting); *Royka*, 490 F.2d at 985, 180 U.S.P.Q. (BNA) at 583. The Examiner is not willing to view any part of the claims referring to the printed matter as a part of those claims. *In re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1983) is still good law. Obviousness requires a suggestion of all limitations in a claim. *CFMT, Inc. v. YieldUp Int’l Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003).

Applicants further respectfully suggest the gravamen of declarations by persons skilled in the art, implicating the secondary considerations as to obviousness. Attachment 1 to the Response to Office Action is the Declaration of Lynette Damir, R.N., the inventor of the invention, taught in the instant application; Attachment 2 to the same Response is the declaration of Pamela Jordan, Ph.D., R.N. Each of the declarations addresses the absence of a similar product in the marketplace and the surprising results. Both go on to assert additional indicia of uniqueness of the instant invention in the manner set forth as “secondary considerations” in *Graham v. John Deere Co.*, 383 U.S. 1 (1966), where the United States Supreme Court clarified the nonobviousness requirement in United States patent law, set forth in 35 U.S.C. § 103.

Applicants are further concerned about the inconsistent nature of the Examiner's stance. Early on, the Examiner cited *Ketch* (U.S. Patent No. 5,282,749) against the application. Yet, *Ketch* specifically shows the decorative indicia emblazoned on clothes to teach young people how to fold those clothes. Is the Examiner arguing that *Ketch* is an invalid patent, as the very same prior art and arguments would be similarly applicable against *Ketch*? Indeed, the Examiner appears to be asserting that claims to any sort of markings that teach, such as the miter marks of *Bonneville* (U.S. Patent No. 4,934,939); the position marks of *Metzger* (U.S. Patent No. 4,530,349); indication elements of *Posta* (U.S. Patent No. 4,253,197); the paired indicia of *Benjamin* (U.S. Patent No. 3,878,638) over examples of the prior art clothing and bed sheets lacking the indicia and that, per se, these, too, are invalid patents. It appears that the Examiner would find that inch or metric gradations on a stick would not make that ruler patently distinct from an unmarked stick. In short, the claims to the illustrations are related to the blanket, itself; the instant case is much more like *Gulack* than *Nagai*.

3. Conclusion

Applicants wish to thank the pre-appeal brief conference panel for their time and for consideration of the issues raised herein. The pre-appeal brief conference program is believed to be a very efficient and effective tool for advancing prosecution of an Application, and Applicants strongly support the continued use of this program.

Applicants respectfully submit that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that all pending claims are allowable.

Respectfully submitted,

BLACK LOWE & GRAHAM^{PLLC}

A handwritten signature in black ink, appearing to read 'Mark L. Lorbiecki', written over a light gray dotted line.

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